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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,028	12/29/2000	Kristin Carman	06975-139001/Packaging 01	6433
26171	7590	06/08/2004	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/750,028

Applicant(s)

CARMAN ET AL.

Examiner

Yehdega Retta

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 09/964455. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

Claim 29 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of copending Application No. 09/964455. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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*Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological art; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical science as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

The independently claimed steps of obtaining a disk, installing the disk in a case, mailing the case do not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory patent protection. The claimed step of obtaining, installing and mailing does not apply, involve, use or advance the technological arts since claims reciting those steps can be performed by interpersonal communications such that the claimed steps can be performed without a

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physical structure or mechanical object. The method only constitutes an idea of packaging and mailing a disk.

Additionally, for a claimed invention to be statutory the claimed invention must produce a useful, concrete and tangible result. In the present case, the claimed invention produces packaging and mailing of a disk (i.e., repeatable) prediction (i.e., useful and tangible). Although the recited process produces a useful, concrete and tangible result, since claimed invention, as a whole, is not with the technological art as explained above, the claims are deemed to be directed to non-statutory matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito U.S. Patent No. 6,230,964.

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Regarding claims 1-49, Saito teaches a first side and a second side connected to the first side so as to permit the first side to move to the second side between a closed position and an open position, wherein the first side is structured and arranged to define a viewing window; enclosure partially transparent and graphics and promotional information inserted to be visible through the enclosure, ... (see fig.17-23, col. 10 line 10 to col. 18 line 58).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 and 29-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flores Jr. 6,454,090 and further in view of Official Notice.

Regarding claims 1, 3-9 and 22-23, Flores teaches a case comprising of a first side and second side connected as to permit one side to move relative to the second side; first side structured and arranged to define a viewing window; label with information printed on both sides affixed to the side, ... translucent or transparent material to affect the viewing characteristics, ... (see fig. 2 & 6, col. 4 lines 27-57 and col. 6 line 53 to col. 7 line 39). Flores does not specifically teach wherein the viewing window provides a first viewing characteristic that differs from a second viewing characteristic through another portion of the first side. Official Notice is taken that is old and well known in the art of mailing or packaging to provide different viewing windows. Mail packages such as,

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envelops, are well know to provide a viewing area, of different sizes or shapes, on different section of the package, for viewing information without opening the package. One would be motivated to provide limited viewing area, on different section of the package for the purpose of showing specific information, such as the name and address of sender and/or recipient.

Regarding claim 2, Flores teaches a case comprising of a hole (see fig. 2 and col. 4 lines 28-41).

Regarding claims 10-16, Flores teaches first side and second side form a closed cavity and the viewing window enabling perception of the closed cavity (see fig. 2 & 6 and col. 6 line 53 to col. 7 line 16); a disk securing member located with the closed cavity (see fig. 2); an inner surface member (see fig. 1); dimension of the case being greater than Jewel case (see col. 4 lines 5-62); compact disk within the case (see col. 9 line 43 to col. 10 line 67);

Regarding claims 17 and 18, Flores teaches compact disk storing electronic marketing materials comprising computer software (see background and col. 1 lines 27-43).

Regarding claims 19-21, Flores teaches a disk protecting member position around the perimeter to the compact disk (see fig. 2 and 6).

Claims 29, 31-34 and 43-44 are rejected as stated above in claims 1, 3-6 and 22-23 respectively.

Claim 30 is rejected as stated above in claim 2.

Claims 35-40 are rejected as stated above in claim 10-16.

Claim 41 is rejected as stated above in claim 18.

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Claim 42 is rejected as stated above in claim 20.

Claims 24-28, and 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flores Jr. 6,454,090, and further in view of Saito U.S. Patent No. 6,230,964.

Regarding claims 24-28 and 45-49, Flores teaches marketing information printed on the label affixed to the case, however does not teach first side of a label containing information identifying intended recipient. Saito teaches a postal package, transparent, with a cut-out window for mailing a disk wherein the front being marked to which the address and postage stamp art to be affixed (see col. 1 lines 16-65 and col. 14 lines 54-64). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Flores case by implementing Saito's packaging system by printing recipients address and affixing a postage stamp for the purpose of mailing the package to recipient. Flores does not specifically teach a wrapper around the case or disk positioned outside the case. Official notice is taken that is well known in the art of packaging to wrap a case before shipping it to recipient. One would be motivated to wrap the case before mailing it, in order to protect the disk from being used before reaching the intended recipient. No patentable weight is given to the claimed limitation of position the disk outside the case since what is claimed does not change the structure of the claimed device.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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Ban, U.S. Patent No. 5,775,492 teaches card for mailing a product.

Makinen et al. U.S. Patent No. 5,794,772 teaches container for compact disc with window.

Liu U.S. Patent No. 6,540,071 teaches case for holding two compact discs.

Sankey et al. U.S. Patent No. 6,698,586 teaches storage container for disc-shaped items for recorded media.

Rufo, Jr. et al. U.S. Patent No. 6,283,283 teaches compact disc package.

Cinquina U.S. Patent No. 6,629,600 teaches CD container in with round hole opening on the top side of the container.

Fantone et al. U.S. Patent No. 5,914,382 teaches box container and display frame with multiple view optics.

Van Witt et al. U.S. Patent No. 5,738,221 teaches compact holder package containing a three-dimensional pop-up display.

O'Brien et al. U.S. Patent No. 5,372,253 teaches holder/end cap for storage package.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yehdega Retta  
Primary Examiner  
Art Unit 3622

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